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May 31, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Leonard H. Bieman	Examiner: Hoa Q. Pham
Serial No.:	09/111,978	Group Art Unit: 2877
Filed:	July 8, 1998	Docket: 139.045USR
Appeal No.:	2004-0659	Date of Hearing: December 8, 2004
Title:	SCANNING PHASE MEASURING METHOD AND SYSTEM FOR AN OBJECT AT A VISION STATION	

By: Charles A. Lemaire
Name: Charles A. Lemaire
Reg. No.: 36,198

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Charles A. Lemaire
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S/N 09/111,978 PATENT

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REQUEST FOR REHEARING TO THE BOARD OF PATENT APPEALS AND INTERFERENCES OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

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I. INTRODUCTION

This brief is filed requesting that that Board of Patent Appeals and Interferences (BPAI) rehear In Re Ex Parte Leonard H. Bieman (Appeal No. 2004-0659 regarding reissue Application No. 09/111,978). It is the belief of the Appellant that the BPAI has overlooked and/or misapprehended various points of fact and law as outlined below.

II. EVIDENCE RELIED UPON

1. *In re Pannu v. Storz Instruments Inc.*, 59 U.S.P.Q.2d 1597 (Fed. Cir. 2001)
2. *Hester Industries Inc. v., Stein Inc.*, 46 U.S.P.Q.2d 1641 (Fed. Cir. 1998)
3. Claim 30 of the reissue application
4. *In re Richman*, 409 F.2d 269, 276, 161 U.S.P.Q. 359, 363-64 (C.C.P.A. 1969)
5. *In re Wadsworth and Wickenden*, 43 U.S.P.Q. 460, 464 (C.C.P.A. 1939)
6. *Ball Corp. v. United States*, 29 F.2d 1429, 1437; 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984)
7. *Ex parte Eggert*, Paper 22 of Eggert, 67 U.S.P.Q.2d 1716 (BPAI 2003)
8. Appellant's Brief in Reply to Examiner's Answer (filed Sept. 30, 2003)

III. ARGUMENT SUPPORTING THE REQUEST FOR REHEARING

A. The decision attempts to apply a Bright-Line Rule that was rejected by earlier BPAI and Federal Circuit Precedent

On page 14 lines 17-20, the decision states "Thus, according to the recent case law [*In re Pannu* and *Hester Industries Inc. v., Stein Inc.*], the subject matter surrendered is any claim that does not include the limitations added during the prosecution of the original application." The decision goes on at page 14 lines 21-24, "We note that although *Hester* and *Pannu* do not explicitly overrule *Richman*, *Wadsworth* and *Ball*, they do indicate a shift in position of the Federal Circuit and are, therefore, controlling."

The decision is believed to have misapprehended the recent case law as overruling years of case law, and as providing a simple, bright-line rule that they determine to say "the subject matter surrendered is any claim that does not include the limitations added during the prosecution of the original application." Appellant respectfully submits that such an easy bright-line rule and an explicit statement that "prior cases were overruled" would have been provided if, in fact, the Federal Circuit had taken that position. Appellant's Brief in Reply to Examiner's Answer (filed Sept. 30, 2003, herinafter "Appellant's Reply"), on page 2 last paragraph – page 3 first paragraph presented arguments quoted from applicable case law (e.g., *Hester*) that recapture rule may be avoided if the reissue claims were sufficiently narrowed despite the broadened aspects of the claims. Further, the "purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects." Appellant respectfully submits that this law has not been overruled.

In *Ex parte Eggert,* (not previously cited by Appellant), the Board rejects a rule that "any reissue claim which does not contain [the added] limitation is impermissible (page 14 lines 10-12 of the Precedential Opinion, Paper 22 of Eggert). That is, Eggert holds that there is no bright-line rule.

B. Appellant's claims are sufficiently narrowed and within the exception to the recapture rule of Federal Circuit and BPAI Precedent

On page 13 lines 17-20, the decision states Appellant "added three limitations to the claims and argued how each limitation differed from the prior art applied against the claims. In

Hester, Williams (the inventor) likewise has argued that two limitations were critical with regards to patentability." On page 12 line 8-page 12 line 15, the decision states that in the present case the limitations "at a substantially constant velocity" and "which are substantially uniformly spaced," which are omitted from claim 30 and other claims, are very much germane to the rejection and thus, surrendered subject matter.

The decision is believed to have misapprehended the rule and applicability of *Hester*. Appellant, when his attorney added limitations during prosecution, did not argue that the limitations added were "critical" to patentability, as Williams had. The rule and the exception stated in *Hester* are to allow the Applicant to correct an error in prosecution by broadening the claims (i.e., removing limitations) while narrowing the claims in a manner applicable to "the rejection," i.e., clearly distinguishing the reissue claims from the prior art. Appellant's Reply, on page 3 lines 16-24, distinguished from *Pannu* and provided an explanation as to how the new limitations narrowed the claims in a manner directly applicable to the rejection.

The decision dismisses Appellant's citations to *In re Richman*, *In re Wadsworth*, *Ball Corp. v. United States*, and the Board's own citation to *Ex parte Eggert* as not controlling case law. On page 13 line 16-page 14 line 17 the decision argues that instead *Hester* and *Pannu* define limitations germane to "the rejection" as requiring the limitations originally added during prosecution. In contrast, "the rejection" is the application of the prior art to the original claim. The decision is believed to have misapprehended the term "limitations germane to the rejection." Appellant's Reply, on page 4 lines 1-3 explains that the new limitation to movement, the new limitation to the fixed relationship, and the new limitation to the detector elements combine to sufficiently narrow the new claims with respect to the original surrendered claims and to the prior art to fall within the exception to the rule.

C. Appellant's claims are also narrowed and within the 3(b) exception to the recapture rule of Federal Circuit and BPAI Precedent

On page 13 lines 17-20, the decision states "three detector elements at first, second, and third phases, respectively, despite appellants arguments to the contrary we find that this limitation does not further narrow patent claim 1." Specifically, claim 1 recited "a plurality of

separate detector elements which are substantially uniformly spaced," which implies that there are at least three detector elements (or the spacing limitation makes no sense)."

The decision is believed to have misapprehended the extent of the new limitation. The "uniformly spaced" limitation was limitation added in prosecution. As explained in the Appellant's Reply, on page 4 lines 4-14. The new claims include a limitation specifying at least three elements is narrower than the original claim in a manner directly germane to the prior-art rejection, which takes the reissue claims into the 3(b) exception analysis of broadening reissues.

IV. CONCLUSION

For the foregoing reason, the Appellant respectfully requests that the BPAI reconsider its earlier decision and reverse the Board's earlier decision.

Respectfully submitted,

LEONARD H. BIEMAN

By his Representatives,

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Date 31 May 2005 By _____
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CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office at Fax No. (703) 872-9306 on this 31st day of May, 2005.

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